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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,432	03/02/2004	Juergen Benz	588.1016	5411
23280	7590	07/18/2005	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			LE, DAVID D	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,432

Applicant(s)

BENZ ET AL.

Examiner

David D. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the first Office action on the merits of Application No. 10/791,432, filed on 02 March 2004. Claims 1-19 are pending.

Documents

2. The following documents have been received and filed as part of the patent application:
 - Foreign Priority Document, received on 03/02/04
 - Declaration and Power of Attorney, received on 04/23/04

Oath/Declaration

3. The oath or declaration, filed on 23 April 2004, is defective because the specification to which the oath or declaration is directed has not been properly identified. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Claim Rejections - 35 USC § 112

4. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an engine braking mode, as described in paragraphs [0006] and [0029],

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does not reasonably provide enablement for the clutch, which is located between a drive motor and an automated manual transmission, to be disengaged/free-wheeling during engine braking mode. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 1-19:

Both independent claims 1 and 18 require the limitation “controlling the clutch so that a free-wheeling function is implemented during an engine braking mode.”

The present specification, i.e., paragraph [0029], defines engine braking mode as follows:

“To enter an engine braking mode, the clutch is slowly engaged and/or a creep torque is built up.”

Accordingly, the present specification does not appear to support the claimed limitation, as mentioned above.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-19:

- Claims 1 and 18 recite the limitation “controlling the clutch so that a free-wheeling function is implemented during an engine braking mode.” This limitation appears to be inaccurate because paragraph [0029] of the present specification requires the clutch to be engaged, not free-wheeling, during engine braking mode.
- Claim 3 recites the limitation "the gear". There is insufficient antecedent basis for this limitation in the claim.
- Claim 4 recites the limitation "the gas pedal". There is insufficient antecedent basis for this limitation in the claim.
- Claim 7 recites the limitations "the driving speed" and “the maximum free-wheeling speed”. There is insufficient antecedent basis for these limitations in the claim.
- Claim 12 recites the limitation “the maximum free-wheeling speed”. There is insufficient antecedent basis for this limitation in the claim.
- Claim 15 recites the limitations "the gas pedal" and “the driver’s desired torque”. There is insufficient antecedent basis for these limitations in the claim.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Shigyo (U. S. Patent No. 6,878,095) teaches an automatic-clutch control system comprising engine-braking feature.
- Brandt (U. S. Patent No. 6,729,198) teaches a method for controlling a multi-speed gearbox having engine-braking feature.
- Genise (U. S. Patent No. 5,425,689) teaches a control system/method for controlling a partially automated transmission comprising a controller for operating engine brake.
- Jones et al. (U. S. Patent No. 5,454,768) teaches a clutch control system having an engine-braking feature.
- Darnell (U. S. Patent No. 5,819,585) teaches a vehicle transmission with automatic safety override and engine-braking feature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ddl

Charles A. Marmor 7/14/05
CHARLES A. MARMOR
SUPERVISORY PATENT EXAMINER
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